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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/089,284	08/15/2002	Andreas Lesche	GK-OEH-127 / 500814.20028	9380
26418	7590	03/29/2005	EXAMINER	
REED SMITH, LLP ATTN: PATENT RECORDS DEPARTMENT 599 LEXINGTON AVENUE, 29TH FLOOR NEW YORK, NY 10022-7650			LEVKOVICH, NATALIA A	
			ART UNIT	PAPER NUMBER
			1743	

DATE MAILED: 03/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/089,284

Applicant(s)

LESCHE ET AL.

Examiner

Natalia Levkovich

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 August 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 August 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the collar must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

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2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 10-12 and 18 are rejected under 35 U.S.C. 112, second paragraph, as being unclear for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 10 recites: "a tip magazine for receiving ...tips of a length L1 with a collar formed around the receiving opening..." It is not clear which opening is meant, since both carrier plate and an orienting plate of the magazine include openings. The Examiner suggests the collar structure to be described in the body of the claim, rather than in the preamble.

Claim 11 recites: "the thickness of the plates added to the distance is only slightly less than the overall length of the tips L1, excluding the collar width..." Since the location and the shape of the collar are not defined, the entire criteria for plate thickness evaluation remain unclear.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 10-12 and 17 are rejected under 35 U.S.C. 102(b) as anticipated by Linder (USP 5,057,282).

Linder teaches a tray for pipette tips which “includes two spaced, substantially parallel panels, each having an array of holes; the arrays are aligned. ...The invention also encompasses flat blanks, one for the tray and one for the shipping enclosure, for forming into the package”(Abstract).

The assembly also comprises two “opposed, substantially rectangular side panels ... secured to the first array panel “. The panels function as spacers ‘fixedly connected to one another’. “The various flaps and panels which are brought into overlying contacting relationship may be secured by various suitable adhesives or by frictional “(Col.3, lines 20-30 ; Col.3, lines 20-30 ; Col.4, line 30; Fig. 1).

“Each of the first array panel ... and the second array panel ...is provided with an array ... of a plurality of through holes or openings ... The openings may be uniformly of a selected diameter as shown or may be a mix of various diameters (not shown). The openings ... forming the array ... on the first and second array holding panels ... are preferably aligned, whereby each of the centers of the openings ... on the panel ... may be placed in vertical alignment with centers of the correspondingly-positioned openings ... in the panel ...The openings ... on the second panel ... may have an enlarged diameter relative to the openings on the first panel “ (Col.3, lines 50-60).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 13—16 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over by Linder (USP 5,057,282) in view of Petrek (USP 6,286,678).

Linder does not teach spacers being in the shape of rods or sleeves.

Petrek discloses a pipette tip array pack comprising “a support plate [‘carrier plate’-Examiner] with an array of holes containing pipette tips arranged in an organized manner and including a guide for centering and guiding the support plate onto the tip rack with distal end portions of the pipette tips aligned with corresponding holes in an organizing tray [‘orienting plate’-Examiner] in the tip rack, the support plate including vertically extending lateral support means [‘spacers’-Examiner] adjacent at least some of the holes in the plate...”(Abstract).

“Adjacent each pipette tip receiving hole in the improved tip support plate is lateral support

means for the tip confined in the associated support hole. Each such lateral support means comprises one or more vertically extending support surfaces...'(Col.3, line 50).

The lateral support surfaces ['spacers'-Examiner] "may take various forms including a plurality of rod-shaped posts 80 (FIG. 5), or rectangular posts 81 (FIG. 7) or arcuate collar sections 82 (FIG. 6) extending vertically from the plate and spaced circumferentially around each tip receiving hole in the improved support plate. Alternatively, the support surfaces 78 may comprise vertically extending enclosures 83 around each such hole such as a rectilinear grid 86 of vertically extending cross members 88 and 90 (FIG. 8) or preferably, as illustrated in FIG. 1, a vertically extending collar 84 [sleeve'-Examiner] surrounding each hole..." (Col.8, lines 45-55).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have employed spacers shaped like rods or sleeves in the modified assembly of Linder, in order to prevent the lateral displacement of the tips and to improve overall rigidity of the structure. With respect to the rods being 'centered between four holes', it would have been obvious to one of ordinary skill in the art at the time the invention was made to have employed the above arrangement in the modified structure of Linder, in order to evenly distribute the load over the assembly and to enhance its stability and security.

In regards of claim 13, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have employed a spacer having a shape of handle in the modified assembly of Linder, in order to provide more convenient handling of the apparatus. As to claim 18, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have employed through holes of different shapes, such as circular or

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rectangular, in the modified assembly of Linder, in order to accommodate pipette tips of various types and to provide adequate frictional retention of a given tip.


Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalia Levkovich whose telephone number is 571-272-2462.

The examiner can normally be reached on Mon-Fri, 8 a.m.-4p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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